

### **DETAILED ACTION**

The remarks in the RCE are dully noted. Based on the continually of recitations of the broad claims presented, it appears that the applicant has not made a reasonable attempt to advance prosecution. Since the originally filing in 2001, the examiner has issued several Office Actions for this application. The applicant is advised to view Chapter 1200 of the MPEP for assistance in advancing the prosecution of this case.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 4 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 12/172,993. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the application is totally encompassed within the claim of the copending application. In this instance the application is broader in scope than the copending application due to the omission of some minimal features (i.e., energy source, one or more transceivers) which are listed in the copending application. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention as made to delete these features from the apparatus of the copending application for the purpose of making the device more economical to produce.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 11, 19, 21, 22, 26-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with indefiniteness that are too numerous to point out in every instance. The following examples are provided for the applicant's use in making corrections wherever appropriate but not specifically pointed to.

Regarding claim 4, Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "tactile" in claim 4 is used by the claim to mean "displaying to a user", while the accepted meaning is "perceptible by touch." The term is indefinite because the specification does not clearly redefine the term.

Regarding claim 33, the limitation "similar types" is vague and indefinite because it is not clear what "types" are encompassed by the phrase "similar types of devices".

Regarding claim 35, it is not clear what is meant by the phrase "the tactile stimuli comprises an expansion of the output component". It is not clear how the stimuli is expanded when displayed to a user (see claim 1). Clarification of the scope of the claim is required in response to this Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4 and 11, as best as understood, are rejected under 35

U.S.C. 102(e) as being anticipated by 6,744,370 to Sleichter, III et al (hereinafter Sleichter). Sleichter discloses a powered interactive apparatus comprising an energy source (column 2 lines 51-61), a least one transducer (abstract), at least an input signal (microprocessor controller), one or more transceivers (45) an output component (vibrators 12 in pad 14), means for remotely controlling (36). In that the structures are met by Sleichter, it is presumed to be inherently capable of the claimed functions.

Claims 4, 11, 19, 21, 22, 26, 29, 31, 36-38, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kikinis.

The device of Kikinis teaches the elements of the claimed invention including energy source (power supply 33), at least one transducer (column 5, lines 56-67 of the

specification), transmitters and receivers (col. 9, par. 2), an output component (73 and 75), a means for remote controlling (fig 2), at least one means for recording and playback means (column 8, lines 52-57 of the specification). Kikinis also discloses at least one hybrid audio and video tactile transducer (column 3, lines 54-55 and 66-67 and column 4 lines 1-4 of the specification). Kikinis further teaches that two or more individual plays the apparatus (col. 8, par. 6), a handheld device (the doll) and removable outer covering not necessary for operation of the apparatus (the doll clothing).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 28, 30 and 32-35 as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis.

Kikinis teaches most of the elements of the claimed invention except for communication between the apparatus and another apparatus and at least one casino style game. Kikinis teaches that one or more interactive dolls can be supported by the computer. Therefore, it would have been obvious to one of ordinary skill in the art to provide another apparatus for the device of Kikinis for the purpose of interacting with an individual as a

knowledgeable and articulate companion. Further it would have been obvious to one of ordinary skill in the art to modify the device of Kikinis to include a casino game for the purpose of interacting with the individual.

Regarding claims 32-35, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use another apparatus, including the elements as claimed, with the device of Kikinis, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Response to Arguments***

Applicant's arguments filed 2/16/10 have been fully considered but they are not persuasive. The applicant's attention is directed to the above rejection.

### ***Conclusion***

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent

Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bena Miller/  
Primary Examiner, Art Unit 3725  
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